

REMARKS

Claims 1-31 remain in the application for further prosecution. Claims 2 and 12 have been amended to correct the informality, as suggested by the Examiner.

Allowable Subject Matter

The Examiner has indicated that the subject matter of claims 2 and 12 is allowable, except for the correction of the term "outcomes" (plural). The correction has been made. The Applicants appreciate the indication of allowable subject matter in claims 2 and 12.

§§ 102 and 103 Rejections

Claims 1, 3-9, 11 and 13-19 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,976,016 (Moody et al.).

Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,976,016 (Moody et al.) as applied to claims 1 and 11 above, and further in view of U.S. Patent No. 6,089,976 (Schneider et al.).

Claims 21-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,089,976 (Schneider et al.).

Claims 1 and 11

Claims 1 and 11 were again rejected under 35 U.S.C. § 102(b) as being anticipated by Moody. The Applicants respectfully request the Examiner to again reconsider this rejection. The Examiner's rejection based on Moody in the Final Office Action dated April 12, 2006 is identical to the initial rejection set forth in the Office Action dated March 11, 2005. However, the Final Office Action includes a few additional points of clarification on the Examiner's underlying position for making this rejection based on Moody. As noted below, the Applicants do not agree with the Examiner's underlying position.

First, the Examiner discusses the term "comprising" as used in claims 1 and 11 and suggests that this common transitional phrase has some bearing on how to interpret specific language located within one claim element. In particular, the Examiner states that the use of the term "comprising" in the preamble somehow allows for an additional broad interpretation of the

phrase “each one of the plurality of selectable elements being associated with a corresponding one of a plurality of respective outcomes.” However, the Examiner’s reliance on the use of the term “comprising” to arrive at the Examiner’s overly broad and unfair construction of this claim element is misplaced.

In particular, the Applicants direct the Examiner’s attention to the MPEP § 2111.03. The term “comprising” is one of a few common transitional phrases used in a preamble of a claim. As stated clearly in this section, the purpose of these transitional phrases is to determine whether additional claim elements are steps are included or excluded from the scope of the claim. The term “comprising” simply means that the stated claim elements or steps are essential to the claim, but that other elements or steps may be added while still falling within the scope of the claim. For example, in claim 1, the use of the term “comprising” means that an accused 3rd party process (for purposes of determining infringement) or a piece of prior art (for purposes of determining patentability) that has all of the elements of claim 1, but includes an additional step, such as “displaying an animated pattern encompassing the selected element and at least one of the non-selective elements” (see claim 10), would still fall within the scope of claim 1. Contrary to the Examiner suggests, the law regarding transitional phrases, such as “comprising,” has nothing to do with how to construe the internal language within one specific claim element. As such, the Examiner’s basis for attempting to overly broaden the scope of the clearly written claim elements of claims 1 and 11 is legally baseless.

In effect, Examiner has rewritten claims 1 and 10 such that “each one of the plurality of selectable elements being associated with a corresponding one of a plurality of respective outcomes” is equivalent to “each one of the plurality of selectable elements being associated with multiple corresponding ones of a plurality of respective outcomes.” See Page 9 of the Office Action. Even if such a construction were fair and proper (which it is not), the Applicants respectfully request the Examiner to consider the following question -- what “outcome” corresponds to Moody’s single “star” symbol that the player has held (note the player in Moody has chosen to hold three different “star” symbols in Moody’s Figs. 2-3)? Further, what “multiple outcomes” (using the Examiner’s overly broad construction) corresponds to Moody’s single “star” symbol that the player has held? The answers are clear – there is no outcome or outcomes corresponding to Moody’s single “star” symbol. Each of Moody’s outcomes is

associated with symbol combinations (i.e., multiple symbols), not a single symbol, as show in Moody's Table 1.

The Examiner's argument with respect to the "outcomes" in the paragraph bridging pages pp. 9-10 does not address the positions raised in the Applicants previous reply, which focused on the fact that these claims 1 and 10 require outcomes (plural). In other words, claims 1 and 10 require that there are at least two "outcomes" because the plural form ("outcomes" not "outcome") of the word "outcome" has been specifically used in claims 1 and 10. Furthermore, this last element in claims 1 and 10 refers to "the" outcomes, which has an antecedent basis going back to the second elements in claims 1 and 10 (stating "each one of the plurality of selectable elements being associated with a corresponding one of a plurality of respective outcomes.") Hence, there is an "outcome" associated with the selected element and there is an "outcome" associated with the non-selected element, which, together, leads to the phrase "awarding to the player the outcomes associated with the selected element and at least one of the non-selected elements."

The Applicants note that, when rejecting claims 4 and 14 and claims 5 and 15, the Examiner correctly understood that an "outcome" could be a monetary payoff and that an "outcome" could be the ability to play a "bonus game." Yet, the Examiner's correct understanding of an "outcome" in claims 4 and 5 and claims 14, 15 is directly contrary to the Examiner's own statement in the original Office Action and again on page 3 Final Office Action, which states, "[t]his correlates to at least the ... and the Respective outcomes are represented with the initial game selection of symbols shown in FIG. 1." The Applicants have no idea what this statement means -- how is it possible that FIG. 1 of Moody discloses any "outcomes" that are awarded to the player? In summary, considering the Examiner's correct understanding of what an "outcome" can entail as set forth in the rejections of claims 4, 5, 14, and 15, the Applicants respectfully request the Examiner to consider the following questions – what "outcome associated with" the selected element in Moody's FIG. 1 is Moody's player awarded and what "outcome associated with" the non-selected element in Moody's FIG. 1 is Moody's player awarded? The answer is – none. Again, the player in Moody is award an outcome (e.g., a payout) associated with a symbol combination.

Finally, the Applicants note that the references to the specification in the Applicants' previous reply was for the purpose of trying to explain what the invention was to the Examiner. It appeared to the Applicants that the Examiner did not fully understand what was being claimed, and the Applicants were attempting to explain the claims in light of an example set forth in the specification. Contrary to the Examiner statements, nowhere did the Applicants suggest that the limitations in the specifications should somehow be read into the claims.

In summary, the Applicants respectfully request the Examiner to reconsider the positions and withdraw the rejections of claims 1, 3-11, and 13-21 under 35 U.S.C. §102.

Claims 21-30

The Examiner's position on page 12 in the Final Office Action that the "Applicant appears to be arguing semantics" is baseless. The claim language specifically states that there is a "primary game" and a "secondary game." Both of these terms are extremely well known in the prior art and are used consistently within this area of the technology, as the Examiner is well aware. In fact, the prior art to Schneider that the Examiner relies upon to rejecting claims 21-31 identifies what a primary game is and what a secondary game is, just like the present specification. This is not a game of "semantics" as the Examiner suggests. Quite differently, these claims call for two explicitly stated and distinct claim elements, each of which is well known to have a certain meaning that is different from the other, to have a unique relationship that cannot be found in the prior art. It is the Examiner that persists in swapping the definition of "secondary game" and the definition of "primary game" while ignoring definitions that are commonly known to those of skill in the art.

In the last reply, the Applicants presented a myriad of reasons why claims 21-31 cannot be contorted, in the manner that the Examiner suggests, such that the prior art anticipates them or renders them obvious. See pages 11-13 of the Reply dated June 15, 2005. Those positions are already preserved for appeal and, thus, will not be reiterated.

Now, in the Final Office Action, the Examiner further clarifies the rejection by noting that "the features of a 'first' and 'second' bonus game were clearly and distinctly addressed in the rejection the claims based upon the prior art." Page 11. The plain language of claims 21-31 does not deal with first and second bonus games. These claims are concerned with a primary

game and a secondary game. Hence, it is also unclear to the Applicants how this argument is relevant to claims 21-31.

Lastly, in the final paragraph on page 12 of the final Office Action, it appears that the Examiner admits that Schneider does not disclose conducting a secondary game in response to a start-secondary game outcome in the primary game and without requiring an additional wager. Yet, the Examiner then states “allowing the player to acquire a free primary game in a bonus game wherein the primary game initially required a wager to initiate provides for the present claim limitation” and cites to FIG. 7 of Schneider in a parenthetical. Yet, Schneider's FIG. 7 simply discloses a flowchart in which the primary game is played after receiving a wager. There is no mentioning of a “secondary game” in FIG. 7. More importantly, Schneider's “primary game” cannot be played unless the player places a wager, as specifically shown in the first two boxes in the upper left-hand corner of the flowchart of Schneider's FIG. 7. As such, Schneider's FIG. 7 is directly contrary to what is being claimed and teaches away from the claimed invention, which does not require the placement of an additional wager to play the primary game.

Without a doubt, claims 21-31 are patentable over Schneider.

Conclusion

If any matters may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact the Applicants' undersigned attorney at the number shown.

Respectfully submitted,



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